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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,661

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Toshio Kiriya

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WENDEROTH, LIND & PONACK, L.L.P.
1030 15th Street, N.W.,
Suite 400 East
Washington, DC 20005-1503

EXAMINER

WILLIAMS, LELA

ART UNIT

PAPER NUMBER

1787

NOTIFICATION DATE

DELIVERY MODE

08/17/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
coa@wenderoth.com

Office Action Summary	Application No. 10/585,661	Applicant(s) KIRIYAMA ET AL.	
	Examiner LELA S. WILLIAMS	Art Unit 1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/08/2010, 06/25/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment filed on April 6, 2010 has been fully considered. The amendment necessitated the new ground of rejection set forth below and therefore, the following action is made final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by

Sugimoto et al. US 4,656,044.

Sugimoto discloses a process for producing an acid-soluble soybean protein-containing solution which comprises preparing an aqueous solution of acid soluble protein and mixing the solution with a polar solvent containing alcohol (col. 2, lines 17-45) to obtain a beverage containing acid soluble protein in a state of dissolution in the polar solvent (Examples 1 & 3). The examples disclose mixing acid soybean milk (which contains soybean protein) with water and shochu (polar solvents) and stirring to obtain a homogeneously dispersed mixture with no protein precipitates, thereby disclosing the protein will be in a state of dissolution. The reference does not expressly teach the protein having a solubility of 60% or more at pH 4.0 or lower however given that the reference teaches a soluble acidic soybean milk identical to that used in the present invention, it is inherent, absent any clear and concise evidence to the contrary that the soybean protein of Sugimoto will have the identical properties of that presently claimed.

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4. Claims 1, 3, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Chinese Patent 1253173.

CN 1253173 discloses a process for producing an acid-soluble soybean protein-containing solution which comprises preparing an aqueous solution of acid soluble protein (page 7, step 2) and mixing the solution with a polar solvent containing alcohol (page 8) to obtain a wine beverage which would naturally have the soybean protein in a state of dissolution. The reference does not expressly teach the protein having a solubility of 60% or more at pH 4.0 or lower; however given that the reference teaches a soybean protein identical to that used in the present invention, it is inherent, absent any clear and concise evidence to the contrary that the soybean protein of CN 1253173 will have the identical properties of that presently claimed. The reference also shows the acid-soluble protein content to fall within the presently claimed range of 0.5 to 20% by weight (page 3).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. WO 02/067690 (US 7,465,470 is being used as a translation) in view of Sugimoto et al. US 4,656,044 or Chinese Patent 1253173.

Regarding claims 1 and 2, Saito discloses preparing an aqueous solution of acid- soluble soybean protein which is soluble in a range of 3.0 to 4.5 (col. 2, line 49-col. 3, line 10) and having high solubility under acidic conditions [abstract]. The reference does not specifically list a solubility of 60% or more, however given that the acid soluble soybean protein of the reference is produced by an identical process as presently claimed, it is obvious that the protein of the reference will have the solubility as presently claimed.

The reference teaches dissolving the protein in a polar solvent (col. 3, lines 60-65); however the reference is silent to the polar solvent containing alcohol. Both Sugimoto and CN

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1253173 disclose mixing an acid-soluble soybean protein-containing solution with a polar solvent containing alcohol. Given the teachings of Sugimoto and CN 1253173, one of ordinary skill in the art would have been motivated to mix the protein of Saito in a polar solvent as in Sugimoto and CN 1253173 to obtain a beverage having a refreshing flavor and which produces no precipitates (Sugimoto, col. 2, lines 13-16).

Regarding claims 4-6, Saito discloses the solution and gel can be utilized in food products (col.2, line 55 & Ex. 10 and 11), can be dried to form a powder (col. 8, line 13 & line 50), and can be molded to form a desired shape (col. 15, line 25 & col. 16, line 20-25).

Response to Amendment

9. Claims 1-6 are currently pending. Claim 7 has been cancelled.

Response to Arguments

10. Applicant's arguments, of Saito, Morehouse, McCabe, and Magnino filed May 17, 2010 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Sugimoto et al. US 4,656,044 and Saito et al. WO 02/067690 in view of Sugimoto et al. US 4,656,044 or Chinese Patent 1253173.

Regarding applicant's remarks concerning CN 1253173, applicant argues that the soybean powder is not dissolved; however, the powder is used in making a wine beverage, which makes it clear the powder is dissolved. CN 1253173 discloses a process for producing an acid-soluble soybean protein-containing solution which comprises preparing an aqueous solution of

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acid soluble protein (page 7, step 2) and mixing the solution with a polar solvent containing alcohol (page 8) to obtain a wine beverage which would naturally have the soybean protein in a state of dissolution. The reference does not expressly teach the protein having a solubility of 60% or more at pH 4.0 or lower; however it is given that the reference teaches a soluble acidic soybean protein, it is inherent, absent any clear and concise evidence to the contrary that the soybean protein of CN 1253173 will have the identical properties of that presently claimed. The reference shows the acid-soluble protein content to fall within the presently claimed range of 0.5 to 20% by weight (page 3).

Regarding applicant's claim that the powder of CN 1253173 is "forcibly dispersed by homogenization", and not dissolved, applicant's attention is drawn to page 7, step 2 of the reference which states "28kg protein powder was added into 140kg water and stirred simultaneously for use after **dissolution**." which means it was dissolved. Thereby giving one of ordinary skill in art motivation to not only consider the art as pertinent art, but to also apply the teachings of the reference.

Applicant's remarks to the date of Saito US Pub 2004/0086624 are correct and the reference is no longer applied. However, Saito WO 02/067690, the prior WIPO publication, is now applied.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LELA S. WILLIAMS
Examiner, Art Unit 1787

/L. S. W. /

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787